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In re Application of:	:	
LAUFF, Markus, et al.	:	DECISION ON PETITION UNDER
U.S. Application No.: 10/583,184	:	37 CFR 1.47(a)
PCT No.: PCT/EP2004/053478	:	
International Filing Date: 15 December 2004	:	
Priority Date: 18 December 2003	:	
Atty's Docket No.: 2058.101US1	:	
For: METHOD AND COMPUTER	:	
SYSTEM FOR DOCUMENT	:	
AUTHORING	:	

This decision is issued in response to applicants' "Rule 1.47(a) Petition To File Application By Other Than All Inventors" filed 05 November 2007. Applicants have paid the required petition fee.

BACKGROUND

On 15 December 2004, applicants filed international application PCT/EP2004/053478. The international application claimed a priority date of 18 December 2003, and it designated the United States. On 30 June 2005, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 18 June 2006.

On 16 June 2006, applicants' filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee and a declaration executed by four of the eight inventors of record.

On 04 April 2007, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirement (Form PCT/DO/EO/905) indicating that a properly executed declaration in compliance with 37 CFR 1.497 was required.

On 05 November 2007, applicants filed a response to the Notification Of Missing Requirements (with required extension fee). The response included declarations executed by two of the previously non-signing inventors, as well as the petition under 37 CFR 1.47(a) considered herein. The petition seeks acceptance of the application without the signature of the remaining two inventors, Florent NICOULAND and Samuel RETHORE, whom applicants assert have refused to execute the application.

DISCUSSION

A grantable petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17; (2) a statement of the last known address of the non-signing inventor; (3) an oath or declaration executed by the other inventors on behalf of themselves and the non-signing inventor; and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort.

With respect to item (1), applicants have submitted the required petition fee. Item (1) is therefore satisfied.

With respect to item (2), the petition does not include an express statement of the last known addresses for the two non-signing inventors. Item (2) is therefore not satisfied.

Regarding item (3), section 409.03(a) of the Manual of Patent Examining Practice (MPEP) states that:

An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Here, applicants have filed declarations executed by six of the eight inventors of record, and these declarations each include unsigned signature blocks for the non-signing inventors, Florent NICOULAND and Samuel RETHORE. These declarations can be accepted as having been executed by the signing inventors on their own behalf and on behalf of the non-signing inventors. Item (3) is therefore satisfied.

Regarding item (4), MPEP section 409.03(d) states that, before it can be concluded that an inventor has refused to execute the application papers, "[a] copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney." The MPEP also states the following:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Finally, the MPEP states:

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted.

Here, as evidence of the inventors' refusal to execute the declaration, applicants have provided a statement from counsel, with accompanying exhibits. However, as discussed below, these materials do not provide an acceptable showing that the non-signing inventors have refused to execute the declaration.

The petition asserts that a copy of the complete application, with a request for signature, was forwarded to the non-signing inventors by email on 05 August 2006. A copy of the email is attached to the petition. However, applicants have not provided a firsthand statement from Nancy Cournoyer, the person who forwarded this email, as required to confirm the correspondence and enclosures. Moreover, a subsequent email by Ms. Cournoyer, dated 15 August 2006 (a copy of which is included with the present petition) states that the 05 August 2006 email correspondence was returned as undeliverable. It is noted that, as indicated in the MPEP, the complete application materials, accompanied by a request for signature, should be sent to the last known address of the non-signing inventors. The emailing of such requests and documents, even if these emails are not returned as undeliverable, is generally not considered sufficient to satisfy this requirement. Accordingly, the 05 August 2006 email, which apparently was never delivered to the non-signing inventors, does not support a conclusion that the non-signing inventors have refused to execute the declaration.¹

The petition also refers to the mailing of a request for signature to the non-signing inventors by a representative of the assignee, Christine Chaux-Luedtke. A copy of an email from Ms. Chaux-Luedtke is included with the petition. The email refers to attempts to forward "by registered mail the documents to be executed" to the non-signing inventors, and states that the registered mail was delivered to inventor RETHORE, but not to inventor NICOULAND (copies of un-translated mail receipts are included with the petition). However, applicants have not provided a firsthand statement from Ms. Chaux-Luedtke to confirm and clarify the referenced actions (for example, it is not clear if the mailings included a copy of the complete application, or just the declaration and assignment documents, nor is it clear whether the address used for Mr. NICOULAND was current). Without the required firsthand statement and further supporting documents (i.e., copies of cover letters and receipt confirmations, with English translations), the registered mailings referred to in the petition do not support a determination that the inventors have refused to execute the application.

Based on the above, item (4) of a grantable petition is not satisfied on the present record. Applicants must provide adequate supplemental materials that satisfy the requirements of the MPEP and include firsthand statements (with documentary support) confirming that a request for signature, accompanied by a copy of the complete application, has been sent to the non-signing inventors at their last known addresses, and that the inventors have refused to provide the requested signatures in response to such requests.

¹ The petition also refers to a subsequent attempt to reach the inventors by email, this time by Dennis Wong on 17 April 2007. As with the 05 August 2006 emails, applicants have not provided a firsthand statement to confirm the details of this correspondence (for example, were these emails returned as undeliverable, like the 05 August 2006 emails?). In addition, it does not appear that a copy of the complete application was attached to these emails.

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)" and must include the additional materials required to satisfy items (2) and (4) of a grantable petition, as discussed above and in the MPEP. No additional petition fee is required.

Failure to file a proper response will result in abandonment of the application. Extensions of time are available under 37 CFR 1.136(a)

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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